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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/822,663

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EXAMINER

WRIGHT, PATRICIA KATHRYN

ART UNIT

PAPER NUMBER

1797

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/822,663	TAKAHASHI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	P. Kathryn Wright	1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 12 and 20-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12 and 20-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Status of the Claims***

1. This action is in response to papers filed January 29, 2009 in which claims 12, 21-23 were amended. The amendments have been thoroughly reviewed and entered.

The previous rejections in the Office Action dated July 29, 2009 are withdrawn in view of the amendments. Applicant's arguments have been thoroughly reviewed but are deemed moot in view of the amendments, withdrawn rejections, and new grounds for rejection. New grounds for rejection, necessitated by the amendments, are discussed. Any objection/ rejection not repeated herein has been withdrawn by the Examiner.

Claims 12 and 20-26 are under prosecution.

### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "identifying unit" and "information storing section" in claim 12 must be shown or the feature(s) canceled from the claim(s). Note that it is required drawings show every feature claimed. Thus, Applicant's statement that where no functional block is illustrated for any claimed structural element "it can be assumed that person of ordinary skill in the automatic analyzer art can supply the details of such missing features in drawings" is not germane to the issue (see REMARKS section on page 6, penultimate paragraph, filed January 29, 2009). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended

replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: “identifying unit” and “information storing section” in claim 12.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 12 and 20-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 12 previously recited a controller for identifying a sample in the sampler container. Now claim 12 recites a methodology performed by the controller wherein the "identifying unit" identifies a sample in the sample container on the basis of information by the information reader and the identifying unit to *again perform* the identifying of a sample in the sample container. This new controller process is not supported by the original disclosure. The Examiner cannot locate support in the original specification for the "identifying unit", nor has Applicant disclosed where such support can be found in the specification. This is considered new matter.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 12 and 20-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As discussed previously, claim 12 now recites an "identifying unit". This recitation is confusing and indefinite. What does the identifying unit correspond to?

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 12 and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP Pub. no.10-019899 to Susumu et al., hereinafter "Susumu", in view of Ishizawa et al., (US Patent Pub. No. 2002/0064481), hereinafter "Ishizawa".

Susumu teaches an automatic analyzer comprising:

a sample dispensing mechanism 12a, 12b that dispenses a sample from a sample container;

a sample container rack 5 arranged to accommodate a plurality of sample containers, including the sample container, and to linearly transfer the sample containers to sample dispensing positions 11, 23 of the sample dispensing mechanisms 12a, 12b, see paragraph [0017] of the provided English machine translation;

reaction vessels 13a, 31b in which samples dispensed by the sample dispensing mechanism are discharged;

a measuring unit (photometer in analytical module A and B, not shown) that measures reactions in the reaction vessels;

an information recording medium (bar code) attached to the sample container that stores information for identifying a sample in the sample container (see paragraph [0023]);

an information reader 6, 10, and 22 arranged to read, when the sample container is positioned at an information reading position in modules A and B, the information recorded on the information recording medium (bar code) attached to the sample container positioned at the information reading position;

an identifying unit that identifies a sample in the sample container on the basis of information read by the information reader, (this reads on computer software in the Susumu system that must identify and process the information read by the bar code reader);

an information storing section (controller memory) that stores identified results identified by the identifying unit; and

a controller that controls the information readers 6,10 to perform the reading of information recorded in the information recording medium prior to a first sample dispensing operation in the analytical module A of the sample dispensing mechanism 12a, the information storing section (computer memory) to perform the storing of identified results identified by the identifying unit, the information reader 22 to again perform the reading of information recorded in the information recording medium just before a second sample dispensing operation of the sample dispensing mechanism 12b, and the identifying unit to again perform the identifying of a sample in the sample container, wherein the controller further checks whether or not the sample to be dispensed is a sample whose information has been previously read by the information reader 6 prior to the first sample dispensing operation (see paragraphs [0010], [0017] and [0019]).

Although the claim recites “an information reader” and “a sample dispensing mechanism”, the use of the indefinite articles “a” and “an” is generally accepted in patent parlance to mean “one or more”. Thus, the plurality of barcode readers 6, 10, and 22 and sample dispensing mechanisms 12a, 12b in Susumu anticipate the claimed “information reader” and “sample dispensing mechanism”, respectively. See the Federal Circuit case of *Tate Access Floors v. Maxcess Techs.*, 222 F.3d 958,966 (Fed. Cir. 2000). See also, *Elkay Mfg. Co. v. Ebco Mfg. Co.*, 192 F.3d 973, 977, 52 USPQ2d 1109, 1112 (Fed. Cir. 1999).



As discussed above, Susumu a sample container rack 5, arranged to accommodate a plurality of sample containers, including the sample container, arranged to linearly transfer the sample containers to sample dispensing positions 11, 23 of the sample dispensing mechanisms 12a, 12b. However, Susumu does not teaches a sample container disk, arranged to accommodate a plurality of sample containers arranged circularly on the sample container disk, and rotated to transfer the sample containers to a sample dispensing position of the sample dispensing mechanism. However, the use of sample disks or racks for transporting sample containers along an analyzer system is considered conventional, see for example Ishizawa.

Ishizawa teaches it is well known in the prior art to transport a number of sample containers containing the sample to be analyzed using a sample disk or rack as the mode of holding the containers, see paragraph [0006].

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to substitute the sample rack and conveyor system that transports the sample containers along the various elements of the Susumu analyzer with a sample disk that rotates the containers along the various elements of the analyzer, as taught by Ishizawa, since these are recognized in the art as structural equivalences in that they perform the same function specified in substantially the same way to produce substantially the same result.

As to claim 20, the controller of Susumu controls the sample dispensing mechanism 12a to suck a liquid from the container when the liquid to be sucked is the same liquid whose information has been already read by information reader 6.

With respect to claim 21, Susumu teaches wherein the controller issues an alarm when a sample that has been dispensed by dispenser 12a and the sample information read by information reader 23 is different from the sample information previously read by the information reader 6, 10 (see col. 6, lines 16 et seq.)

### ***Response to Arguments***

12. Applicant's arguments with respect to claims 12 and 20-26 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

13. No claims allowed.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Kathryn Wright whose telephone number is (571)272-2374. The examiner can normally be reached on Monday thru Thursday, 9 AM to 6 PM, EST.

16. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PKW

/Jill Warden/  
Supervisory Patent Examiner, Art Unit 1797